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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,484	12/26/2000	Hiroyo Masuda	FUJH 18.158	4369
7590	08/10/2005		EXAMINER	
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			BEAMER, TEMICA M	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/749,484

Applicant(s)

MASUDA ET AL.

Examiner

Temica M. Beamer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-6, 8-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6, 8-11, 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/21/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. The indicated allowability of claims 2-6, 8-11 and 13 is withdrawn in view of the newly discovered reference(s) to Amin et al, U.S. Patent No. 6,560,455, Rune, U.S. Patent No. 6,212,390, Clapton et al, U.S. Patent No. 6,192,237 and Bartle et al, U.S. Patent No. 6,018,655. Rejections based on the newly cited reference(s) follow. Hence, the finality of the last office action is withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 recites the limitation "the means for notifying" in line 2. There is insufficient antecedent basis for this limitation in the claim. The examiner will interpret the claim as best understood (i.e., as if it should depend on claim 8 as opposed to claim 2).

### ***Claim Objections***

4. Claims 10 and 11 are objected to because of the following informalities: In lines 9-14 of claim 10, and lines 1-6 (page 5) of claim 11, the wording of the claims is unclear. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Amin et al (Amin), U.S. Patent No. 6,560,455.

Regarding claim 2, Amin discloses a radio switching system comprising a mobile subscriber (col. 3, lines 40-41); a base station controller for controlling a transmission and reception of a signal from the mobile subscriber within its own cell (inherent to cellular systems); a mobile switching center connecting with a plurality of base station controllers (col. 5, lines 13-24) and a home location register for storing home zone information indicating whether or not the mobile subscriber is a subscriber of a home zone service, which restricts a moving area of the mobile subscriber (col. 5, lines 40-52), wherein the mobile switching center judges responsively to a position registration request inside/outside a home zone by the mobile subscriber, whether or not the registration is accepted in the home zone, based on the home zone information transmitted from the home location register (col. 5, lines 25-52, col. 6, lines 32-48 and col. 7, lines 21-29) and wherein each time a radio area is changed by a handover, the mobile subscriber, based on home zone information, the mobile switching center

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further performs a processing in response to registration conditions inside/outside the home zone of the mobile subscriber (col. 5, lines 17-52).

7. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Rune, U.S. Patent No. 6,212,390.

Regarding claim 13, Rune discloses a method of collecting accounting information in a mobile switching center in a radio switching system, the method comprising receiving from a switching center accounting information which the switching center generates based on controlling a handover and editing the accounting information based on account conditions in accordance with the handover, wherein the accounting information contains a subscriber identifier, and recognition information including one of interior and exterior of a home zone assigned to the subscriber identifier (col. 5, lines 25-52 and col. 6, lines 32-57).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Amin in view of Rune, U.S. Patent No. 6,212,390.

Regarding claim 3, Amin discloses the radio switching system according to claim 2 as described above. Amin, however, fails to disclose wherein the registration conditions inside/outside the mobile subscriber are a service condition and the number of times of allowable handover.

In a similar field of endeavor, Rune discloses restricted mobility areas. Rune further discloses the limitations of claim 3 (col. 9, lines 39-56).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Amin with the teachings of Rune for the purpose of ensuring the mobile unit has permission to use the communication system before unnecessarily terminating a call. (Rune (col. 9, lines 51-56).

10. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amin in view of Clapton et al (Clapton), U.S. Patent No. 6,192,237.

Regarding claim 4, Amin discloses the radio switching system according to claim 2 as described above. Amin, however, fails to disclose the system further comprising a plurality of the MSC's wherein the change of the radio area by the handover of the mobile subscriber strides over the plurality of the MSC's, the home zone information is added to existent handover messages and is transmitted and received between the plurality of MSC's.

In a similar field of endeavor, Clapton discloses a call set-up process. Clapton further discloses the limitations of claim 4 (col. 4, lines 45-67).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Amin with the teachings of Clapton for the purpose of keeping an accurate record of the mobile's movement.

Regarding claim 5, the combination of Amin and Rune discloses the radio switching system according to claim 2 wherein the mobile switching center collects a history in the handover during speaking by a telephone as accounting information (Clapton, col. 4, lines 45-67).

Regarding claim 6, the combination of Amin and Rune discloses the radio switching system of claim 5, wherein the history in the handover is the number of times of handover, positions of an ex-address and new address, or cell information (col. 4, lines 45-67).

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amin in view of Bartle et al (Bartle), U.S. Patent No. 6,018,655.

Regarding claims 8 and 9, Amin discloses the switching system according to claim 2 as described above. Amin, however, fails to disclose the radio switching system comprising means for notifying (by sending audible or text information) the mobile subscriber of the point of time when an access by the mobile subscriber is caused and a fact that the subscriber is inside or outside the home zone during speaking by the telephone.

In a similar field of endeavor Bartle discloses imminent change warning in a cellular system. Bartle further discloses the limitations of claims 8 and 9 (col. 10, lines 48-67, col. 9, lines 25-40).

### ***Conclusion***

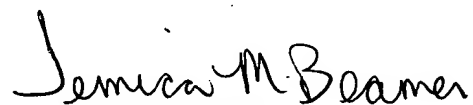
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Beamer whose telephone number is (571) 272-7797. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 7:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Beamer  
Primary Examiner  
Art Unit 2681

August 3, 2005

  
**TEMICA BEAMER**  
**PRIMARY EXAMINER**